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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,275	12/12/2003	Bin-Yen Yang	JCLA10633	3606
23900	7590	03/25/2005	EXAMINER	
J C PATENTS, INC. 4 VENTURE, SUITE 250 IRVINE, CA 92618			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

Office Action Summary	Application No. 10/735,275	Applicant(s) YANG ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. On page 3 of the specification, applicant states that "[t]he emulsion type modifier can be produced by any available method of emulsion ... polymerization" and that "[t]he composition of the emulsion type modifier may further comprise different types of surfactants for improving stability and reaction rates for emulsion ... polymerization". These statements suggest that the "modifier" invention is an emulsion polymer product and not a mixture of monomers and surfactants as presently claimed. In order for applicant to properly claim their inventive "modifier", it is suggest that applicant insert the tern "prepared be polymerizing an emulsion" before the word "comprising" in the 2nd line of claim 1.

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4. The claims are generally indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For instance:

In claims 1 and 2, it is unclear if the "C6-C12 diester" is in reference to the combined total number of carbons in both of the alkyl groups of the diester or in reference to each individual alkyl group.

In claim 3, it is unclear how "**allyl** acetate" could constitute a "C2-C16 **vinyl** ester"

In claim 4, it is unclear how "ethyl acrylate" (having only two carbons in the alkyl group) could constitute a C4-C8 alkyl acrylate.

Also in claim 4, it is unclear how each of the methacrylates, including methyl methacrylate and 2-ethylhexyl methacrylate, neither of which contain C4-C8 alkyl groups, would constitute "C4-C8 alkyl **acrylates**".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernard (USPN 5,164,444) or Koch et al. (WO 00/36039).

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Each of Bernard (col. 3, line 57 to col. 4, line 40, col. 5, lines 51-59 and col. 6, lines 30-35) or Koch et al. (page 4, line 32 to page 5, line 25, page 6, lines 21-29 and Example 1) teach emulsion copolymers for PSA's prepared from:

- (a) 20 to 50 parts per hundred of monomers of a C6-C12 diester of a dicarboxylic acid;
- (b) 20 to 35 parts per hundred of monomers of a C2-C16 vinyl ester;
- (c) 25 to 65 parts per hundred of monomers of a C4-C8 alkyl acrylate;
- (d) 0.1.5 to 1.0 parts per hundred of crosslinking monomers, such as containing an acetoacetoxy functional group;
- (e) & (f) up to about 3.5 parts per hundred of anionic surfactant and
- (g) water.

This is understood to be consistent with applicant's invention. Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

7. Mallya et al. (US Pub. No. 2001/0003765) is made of record and not relied upon, but is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

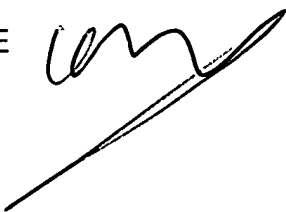
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

A handwritten signature in black ink, appearing to be 'KCE' followed by a stylized flourish, written over a diagonal line.